

REMARKS

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

Claim 1 has been amended to limit the rigid resin part to parts made of acrylonitrile/ butadiene/ styrene resin or polycarbonate resin. Support for this amendment is found on page 3, lines 8 and 9 of Applicants' specification. Claims 16 and 17 have been amended to depend from claim 1.

The rejection of claims 1-19 (claims 14 and 15 are cancelled) as being indefinite under 35 U.S.C. § 112, second paragraph has been obviated by the amendment to claim 1, discussed above.

The patentability of the present invention over the disclosures of the references relied upon by the Examiner in rejecting the claims will be apparent upon consideration of the following remarks.

Thus, the rejection of claims 1, 3-13 and 16-19 under 35 U.S.C. § 103(a) as being unpatentable over Rink et al. in view of Marutani et al. is respectfully traversed.

The Examiner admits that Rink et al. do not teach the fact that the clear paint, as defined in Claim 1 of the present application, further comprises 1-20% by weight of hydroxyl-containing oligomer (C) which is a reaction product of a carboxyl-containing compound with an epoxy-containing compound, based on the combined solid content of the acrylic resin (A) and the curing agent (B). Nevertheless, the Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify the process of Rink et al. to incorporate the star-type polyesters of Marutani et al. in place of one or more other hydroxyl group-containing resin which Rink et al. teach may be included in addition to components (A) and (B).

The Examiner states, "...it would have been obvious to one of ordinary skill in the art to modify the process of Rink so as to incorporate, as the 0 to 25% by weight of one or more other hydroxyl group-containing resins, whereby, for example, the solvent resistance and hardness of the resulting coating are improved further, the star-type polyesters of Marutani. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of successfully reducing the VOC of the coating composition and improving the hardness of the resulting coating."

Rink et al. teach that the coating composition may additionally contain one or more other hydroxyl group-containing resins, and the reference teaches suitable hydroxyl group-containing acrylate resins at column 9, lines 4-41. When these resins are used in place of hydroxyl-containing oligomer (C), as recited in Applicants' claims, they fail to give a clear paint which forms a coating film excellent in adhereability and finishing property. This is clearly demonstrated in Comparative Example 11 of the Rule 1.132 Declaration submitted with the Response of November 14, 2005.

Rink et al. fail to teach or suggest the hydroxyl-containing oligomer (C) of Applicants' claims. Further, Rink et al. fail to provide any motivation to look outside the teachings of the reference for other suitable resins. On the contrary, the disclosure of Rink et al. provides suitable resins. Therefore, any suggestion to look outside the teachings of Rink et al. for other resins is necessarily based on hindsight, which is improper according to U.S. practice. The Examiner has cited no evidence to support the conclusion that it would have been obvious to modify the teachings of Rink et al. to incorporate other resins not taught by Rink et al. In the absence of such evidence, Applicants respectfully submit that, the rejection of claims 1, 3-13 and 16-19 based on Rink et al. in view of Marutani et al. should be withdrawn. In re Zurko, 59 USPQ2d 1693.

Absent hindsight, it would have been impossible to foresee the superior effects which are attained by the use of the specific hydroxyl-containing oligomer (C) in addition to hydroxyl-containing acrylic resin (A) and curing agent (B). One skilled in the art would not have been motivated to use the star-type polyesters of Marutani et al. in place of the hydroxyl group-containing resin of Rink et al., because there is no reason to modify the teachings of Rink et al.

Furthermore, in Marutani et al., the star-type polyesters are used singly as a main binder component. Marutani et al. fail to teach or suggest using the star-type polyesters additionally, in combination with hydroxyl-containing acrylic resin (A) as a main binder component, as in the present invention or Rink et al. One of ordinary skill in the art would not have been motivated, either by Marutani et al. or by Rink et al., to use the star-type polyesters of Marutani et al. in place of the hydroxyl group-containing resin as an additional component in the coating composition of Rink et al.

For these reasons, the invention of claims 1, 3-13 and 16-19 is clearly patentable over Rink et al. in view of Marutani et al.

The rejection of claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Rink et al. in view of Marutani et al., as applied to claim 1 above, and further in view of Asahina et al. and Croft is respectfully traversed.

The Examiner takes the position that one of ordinary skill in the art would have looked to the prior art to find a suitable base coat composition. The Examiner relies on Asahina et al. as teaching a color base coating composition, and Croft as teaching the blocking of polyisocyanates with acetoacetic ester and diethyl malonate.

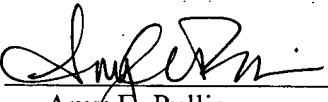
However, as discussed above, the combination of Rink et al. and Marutani et al. do not teach the clear paint composition recited in Applicants' claim 1. Neither Asahina et al. nor Croft remedy the deficiencies of Rink et al. in view of Marutani et al. Therefore, since claim 2 is directly dependent on claim 1, the subject matter of claim 2 is patentable over Rink et al. in view of Marutani et al. for the same reasons that the subject matter of claim 1 is patentable over this combination of references.

For these reasons, the invention of claim 2 is clearly patentable over Rink et al. in view of Marutani et al. and further in view of Asahina et al. and Croft.

Therefore, in view of the foregoing amendments and remarks, it is submitted that each of the grounds of rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

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